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| 53000 7590 04/02/2008 KENYON & KENYON LLP 1500 K STREET N.W. WASHINGTON, DC 20005 | | | | |
| EXAMINER KARDOS, NEIL R | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,633

Applicant(s)

DEITERING ET AL.

Examiner

Neil R. Kardos

Art Unit

3623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a non-final first Office action on the merits. Currently, claims 1-13 and 21-35 are pending.

Election/Restrictions

Claim 14-20 and 36-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 28, 2008.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 21-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 21 recites a system comprising a database, an analytic engine, and an output manager, which could be software. It is not clear how these components that do not necessarily make up a physical structure constitute a system.

The dependent claims 22-35 are also rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 21-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 21 recites a system or apparatus comprising a database, an analytic engine, and an output manager.

These components do not necessarily make up a physical structure. Rather, they merely constitute procedures that do not require an accompanying structure. Such procedures, in a reasonably broad sense, are merely a collection of steps to be followed in order to achieve a desired outcome (i.e. a collection of computer instructions). In a reasonably broad sense, claim 21 is directed to computer instructions that lack any tangible structure. However, claim 21 does not tangibly embody this software on a computer-readable medium. Claim 21 does not recite any physical structure that would serve to constitute a “system.”

Claim 21 also fails to produce a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must produce a useful, tangible and concrete result. An invention which is eligible for patenting under 35 U.S.C 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a useful, concrete and tangible result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a useful tangible and concrete result. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d at 1452 and *State Street*

Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ 2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors:

a) “useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

b) “tangible” - Applying *In re Warmerdam*, 33 F.3d 1354, 31 UAPQ 2d 1754 Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than manipulation of an abstract idea and is, therefore, nonstatutory under 35 U.S.C 101. In *Warmerdam*, the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

c) “concrete” - Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claim 21 recites comparing collected survey data and generating a result. Given a reasonably broad interpretation, “generating a result” could easily produce something that is not useful, concrete, or tangible. The generated result could be an abstraction and thus not tangible. The breadth of the claim language is not specific or substantial because there is no indication of what result is generated; thus the claimed invention does not produce a useful result.

The dependent claims 22-35 are also rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-6, 8-10, 12-13, 21-28, and 30-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent number 7,233,908 to Nelson (“Nelson”).**

Claim 1: Nelson discloses an automated personnel evaluation method, comprising:

- responsive to an indicator of business performance, extracting a segment of E-survey results data corresponding to the indicator (see figure 11, depicting customer satisfaction over time, sorted by dates; column 6: lines 14-21; figures 13-14; column 6: lines 37-58);

- comparing the extracted segment to an aggregate set of E-survey results data (see figure 11, depicting a control chart comparing data; column 6: lines 14-21; figure 18, depicting comparing doctor ratings by age group; figure 8, depicting comparing department satisfaction with overall satisfaction);
- identifying any E-survey results data from the extracted segment that statistically differ from responding results data from the aggregate set by a predetermined amount (see figure 11, depicting a control chart).

Claim 2: Nelson discloses wherein the indicator identifies an organizational unit of a business experiencing anomalous performance (see figure 8, depicting organizational units).

Claim 3: Nelson discloses wherein the indicator identifies a period of time (see figure 11, depicting ratings over time periods; figure 12, depicting date ranges; figure 9: item 286-292).

Claim 4: Nelson discloses wherein the indicator identifies a geographic region (see column 5: lines 60-62, disclosing comparing regions; figure 9: item 292; column 6: line 6, disclosing comparing satisfaction by site).

Claim 5: Nelson discloses wherein the indicator is a key performance indicator (see figures 8 and 11, depicting satisfaction; figure 13b, depicting various KPIs in the satisfaction category; figure 15, depicting KPIs for doctors).

Claim 6: Nelson discloses wherein the indicator is a customer satisfaction indicator (see figures 8 and 11).

Claim 8: Nelson discloses wherein the aggregate set is E-survey results data for a business and the extracted segment is a portion of the aggregate set (see figure 11, depicting a

timeline of the business and specific dates for data; figure 8, depicting overall satisfaction and individual operating unit satisfaction).

Claim 9: Nelson discloses wherein the aggregate set is E-survey results data for a market in which the business participates (see figure 8, depicting a comparison against competitors, e.g. "How do we compare with others," Legend: "You" and "Them"; column 3: lines 54-57).

Claim 10: Nelson discloses comparing the extracted segment of E-survey results data to historical data (see figure 8, depicting a trend in the legend; figure 9: items 286-292; figure 11, depicting comparing individual dates against an aggregate time period on a control chart; figure 12, depicting displaying data by date ranges; column 3: lines 54-57).

Claim 12: Nelson discloses comparing the extracted segment of E-survey results data to key performance indicators (see figures 8 and 11, depicting comparing satisfaction; figure 13b, depicting various KPIs in the satisfaction category; figure 15, depicting KPIs for doctors).

Claim 13: Nelson discloses comparing the extracted segment of E-survey results data to at least one of sales revenues, turn over rates, profit statistics (see figure 7: item 242), cost statistics (see figure 7: item 242), quality statistics (see figures 8, 10, 11, and 14), customer satisfaction rates (see figures 8, 10, 11, and 14) and illness rates.

Claim 21: Nelson discloses a system comprising:

- a survey database to store survey data collected from a survey completed by a plurality of users identified in a survey target list (see column 3: lines 54-57, disclosing a survey database; figure 12, depicting patients targeted age groups and gender; figure 13a, depicting various demographics; figure 18);

- an analytic engine to apply a comparison function to the collected survey data (see column 4: lines 31-37, disclosing performing calculations on survey data; figure 11, displaying compared data; figure 8); and
- an output manager to generate a result based on the applied comparison function (see charts and graphs of figures 8, 10, 11, 14, and 18).

Claim 22: Nelson discloses wherein the output manager is to permit access to the generated result based on pre-determined access rights (see figure 5, depicting a log-in screen).

Claim 23: Nelson discloses wherein the analytic engine is to:

- responsive to an input, extract a segment of the collected survey data (see figure 11, depicting extracted dates); and
- apply the comparison function to the extracted segment (see figure 11, depicting comparing dates to a mean).

Claim 24: Nelson discloses wherein the comparison function applied by the analytic engine is to compare the extracted segment of the survey data to an aggregate set of survey data stored in the survey database (see figure 11, depicting a control chart comparing data; column 6: lines 14-21; figure 18, depicting comparing doctor ratings by age group; figure 8, depicting comparing department satisfaction with overall satisfaction).

Claim 25: Nelson discloses wherein the aggregate set is survey data for a business and the extracted segment is a portion of the aggregate set (see *id.*).

Claim 26: Nelson discloses wherein the aggregate set is survey data for a market in which the business participates (see figure 8, depicting a comparison against competitors, e.g. "How do we compare with others," Legend: "You" and "Them"; column 3: lines 54-57).

Claim 27: Nelson discloses:

- a business information database to store business information (see column 3: lines 54-57, disclosing business databases),
- wherein responsive to the input, the analytic engine is to extract a segment of the business information stored in the business information database (see figure 11, depicting customer satisfaction over time, sorted by dates; column 6: lines 14-21; figures 13-14; column 6: lines 37-58) and
- is to compare the extracted segment of the survey data to the extracted segment of the business information (see figure 11, depicting a control chart comparing data; column 6: lines 14-21; figure 18, depicting comparing doctor ratings by age group; figure 8, depicting comparing department satisfaction with overall satisfaction).

Claim 28: Nelson discloses wherein the extracted segment of the business information relates to historical information (see figure 8, depicting a trend in the legend; figure 9: items 286-292; figure 11, depicting comparing individual dates against an aggregate time period on a control chart; figure 12, depicting displaying data by date ranges; column 3: lines 54-57).

Claim 30: Nelson discloses wherein the extracted segment of the business information relates to key performance indicators (see figures 8 and 11, depicting satisfaction; figure 13b, depicting various KPIs in the satisfaction category; figure 15, depicting KPIs for doctors).

Claim 31: Nelson discloses wherein extracted segment of the business information relates to at least one of sales revenues, turn over rates, profit statistics (see figure 7: item 242),

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cost statistics (see figure 7: item 242), quality statistics (see figures 8, 10, 11, and 14), customer satisfaction rates (see figures 8, 10, 11, and 14) and illness rates.

Claim 32: Nelson discloses wherein the input identifies a period of time (see figure 11, depicting ratings over time periods; figure 12, depicting date ranges; figure 9: item 286-292).

Claim 33: Nelson discloses wherein the input identifies a geographic region (see column 5: lines 60-62, disclosing comparing regions; figure 9: item 292; column 6: line 6, disclosing comparing satisfaction by site).

Claim 34: Nelson discloses wherein the input is a key performance indicator (see figures 8 and 11, depicting satisfaction; figure 13b, depicting various KPIs in the satisfaction category; figure 15, depicting KPIs for doctors).

Claim 35: Nelson discloses wherein the input is a customer satisfaction indicator (see figures 8 and 11).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Official Notice.**

Claim 7: Nelson does not explicitly disclose wherein the indicator is an employee satisfaction indicator.

Examiner takes Official Notice that it is well-known in the management arts at the time the invention was made to measure employee satisfaction. For example, management often asks questions of its employees to determine employee satisfaction levels.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include employee satisfaction surveys in the invention disclosed by Nelson. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by determining employee satisfaction so that steps can be taken to increase employee satisfaction if necessary (thus decreasing turnover rates, absence rates, etc.)

10. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of U.S. patent number 5,909,669 to Havens ("Havens").

Claim 11: Nelson does not explicitly disclose comparing the extracted segment of E-survey results data to external benchmarks.

Havens teaches "compar[ing] selected survey data and manipulations of survey data with appropriate benchmark values." (see column 6: lines 49-57; column 6: lines 34-48, disclosing a benchmark database; column 8: lines 10-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to compare the survey results obtained in the invention of Nelson to external benchmarks as taught by Havens. One of ordinary skill in the art would have been motivated to do so for the benefit of obtaining a more accurate assessment of worker performance (see Havens: column 1: lines 12-22 and 43-55).

Claim 29: Nelson does not explicitly disclose wherein the extracted segment of the business information relates to external bench marks.

Havens teaches "compar[ing] selected survey data and manipulations of survey data with appropriate benchmark values." (see column 6: lines 49-57; column 6: lines 34-48, disclosing a benchmark database; column 8: lines 10-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to compare the survey results obtained in the invention of Nelson to external benchmarks as taught by Havens. One of ordinary skill in the art would have been motivated to do so for the benefit of obtaining a more accurate assessment of worker performance (see Havens: column 1: lines 12-22 and 43-55).

Additional Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. patent number 5,566,291 to Boulton et al, directed to implementing user feedback.

U.S. patent number 5,734,890 to Case et al, directed to analyzing procurement decisions and customer satisfaction.

U.S. patent number 6,687,560 to Kiser et al, directed to processing performance data describing a relationship between a provider and a client.

U.S. patent number 6,411,936 to Sanders, directed to an enterprise value enhancement system and method.

U.S. patent number 6,556,974 to D'Alessandro, directed to evaluating current business performance.

U.S. patent number 6,766,319 to Might, directed to gathering and evaluating information.

U.S. patent number 7,203, 655 to Herbert et al, directed to providing performance statistics to agents.

U.S. pre-grant publication number 2004/0049416 to Alison et al, directed to providing survey services via a network.

U.S. pre-grant publication number 2004/0172323 to Stamm, directed to customer feedback.

U.S. pre-grant publication number 2004/0230989 to Macey et al, directed to survey processing.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
3/26/08

/Beth Van Doren/
Primary Examiner, Art Unit 3623